REMARKS

Applicant has carefully studied the Office Action of 06 October 2003 and offers the following remarks.

Initially, the Patent Office objected to the drawings as failing to show an audio server and issued a rejection under 35 U.S.C. § 112 for claim 29 on the grounds that an audio server was not disclosed in the specification. Applicant herein cancels claim 29, thereby mooting the rejection. Applicant does note that the term is supported in paragraph 49 of the specification, wherein the last sentence indicates that the audio browser 28 may include server processes. This statement encompasses referring to the audio browser 28 as an audio server. However, as noted, the claim is canceled, and the rejection and objection thereof are moot.

Claim 28 was likewise rejected under 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains. Specifically, the Patent Office alleges that while changing a particular type of appearance of the content is disclosed, the generic changing of appearance is not disclosed in such a manner as to enable someone of ordinary skill in the art. Applicant respectfully traverses this rejection. Initially, Applicant notes that the burden is on the Examiner to establish a reasonable basis to question the enablement provided for the claimed invention. MPEP § 2164.04. To determine if something is enabled, the test is articulated as: the claimed invention is enabled if someone of ordinary skill in the art can make and use the invention without undue experimentation. MPEP § 2164.01.

In this particular case, the Examiner has not provided any reasonable basis as to why someone of ordinary skill in the art would not be able to shift from changing color, using capital letters, changing words such as "hi" to "hey men" (see paragraph 38), changing "emotion: sadness" to the emoticon ":(" and the like, without undue experimentation to knowing how to change other aspects of the appearance of the message such as font sizes, underlining, font types, and the like. Since the Examiner has not given any reason or reasonable basis for the uncertainty of the enablement as required, this rejection is improper. Since the rejection is improper, Applicant requests the withdrawal of the § 112 rejection of claim 28 at this time.

Before addressing the rejections based on the references, Applicant provides a summary of the present invention so that the remarks are considered in the proper context. The present invention is designed to facilitate instant messaging between a telephony user and a text based

8

device user (such as a personal computer). The system has an IM proxy that communicates with the IM server and acts like another IM client to the IM server. The IM proxy communicates with an audio browser that in turn communicates with the telephony user. The telephony user further defines a profile that affects how messages from the telephony user are presented to the text based device user. The specific example used in the specification (paragraph 35 and Fig. 4) is personalities. If the profile is specified as "East Coast," then the message meaning "hi" is changed to a number of different phrases, thus changing how it is presented to the second user. Likewise, if, as described in paragraph 38, the personality is defined to be "Caribbean," the message meaning "hi" is changed to "hey mon" also changing the appearance as it is presented to the second user. In addition to the profile, the telephony user may provide characteristics within the message. These commands are uttered in conjunction with the message meaning. Some of the commands are: emotion, volume, and the like. Each of these commands is referenced against the message meaning and the appearance of the message meaning is changed to conform to the command. If the emotion is "sad," the text may be presented in a blue color, or an unhappy emoticon may be appended to the text passed to the second user.

As amended, the independent claims pull elements from claim 2 and 6 into the independent claims. Specifically, the personality portion of the profile is explicitly added to independent claims 1, 13, and 25. Claims 2, 4, 6, 7, and 8 are amended in light of the amendments to claim 1. Claim 14 is canceled in light of the amendment to claim 13.

Claims 1, 4-11, 13, 16-23, 25 and 28 were rejected under 35 U.S.C. § 103 as being unpatentable over Dowens et al. in view of Dutta et al. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where amongst the analogous references all the claim elements are taught or suggested. MPEP § 2143.03. The test for analogousness is set forth in MPEP § 2141.01(a). Specifically, there is a two part test. The reference must be 1) in the same field of endeavor or 2) reasonably pertinent to the particular problem with which Applicant was concerned. A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention when considering his problem.

Applicant has amended independent claims 1, 13, and 25 as described above. The amendments are derived from claims 2 and 6. Specifically, claim 2's profile has been brought

into claim 1. The Patent Office admits that Dowens et al. in view of Dutta et al. fails to teach "providing a profile" (see page 7 of the Office Action, paragraph 5). To this extent, Dowens et al. in view of Dutta et al. does not establish *prima facie* obviousness for the independent claims.

Claims 2, 3, 14, and 15 were rejected under 35 U.S.C. § 103 as being unpatentable over Dowens et al. in view of Dutta et al. and in view of Horvitz et al. Applicant respectfully traverses. Since the profile of claim 2 is now in claim 1, it is appropriate to discuss this rejection as if the rejection could be applied to amended claim 1. Applicant traverses this rejection on the grounds that Horvitz et al. is non-analogous art.

As noted above, the test for analogousness requires an inquiry as to whether the reference is in the same field of endeavor. In this case, Applicant's field of endeavor is instant messaging. The Horvitz reference does not address instant messaging anywhere within its text. To this extent, the reference is not in the same field of endeavor and fails the first part of the analogousness inquiry. Applicant then examines the reference to see if it would have logically commended itself to Applicant's attention when considering the problem of translating voice to text in an instant messaging environment. While Horvitz et al. does discuss profiles being used to create template documents in a word processing document (col. 1, lines 38-45), configuring work spaces at system start up (col. 1, lines 20-24) and extracting dates or other schedule related data from email (col. 2, lines 58-60), there is no teaching or suggestion that it would be appropriate to use the reference in the context of an instant messaging service, much less provide profiles with message characteristics therein for the purpose of affecting the presentation of the message to the text based device user. Thus, the reference does not logically commend itself to an inventor facing the problem of translating audio commands to text based instant messages. To this extent, the reference fails the second part of the analogousness test. Since the reference fails both parts of the analogousness test, the reference is not analogous and cannot be used to support the rejection. Since the reference cannot be used to support the rejection and the remaining references admittedly do not teach or suggest all the claim elements, the combination cannot establish *prima facie* obviousness and the claims define over the rejections of record.

In the event that Horvitz et al. is deemed analogous, Horvitz et al. still does not correspond to the recited claim element. Specifically, a generic teaching of extracting data from a source object and applying the data to one or more target objects does not teach or suggest providing a profile with a message characteristic and modifying how a message meaning is
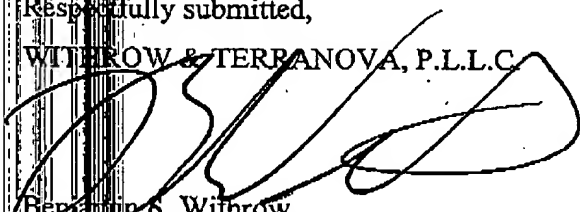
10

presented to a text based device user. This is especially true since the source object of the reference is an email file and the target object of the reference is an electronic calendar file (see col. 2, lines 58-60).

In light the amendments, Applicant respectfully opines that Dowens et al. in view of Dutta et al. with or without Horvitz et al. does not render the claims obvious. Applicant requests reconsideration of the rejection and claim allowance at the Examiner's earliest convenience.

Claims 12 and 14 were rejected under 35 U.S.C. § 103 as being unpatentable over Dowens et al. and Dutta et al. in view of Hodges et al. Applicant respectfully traverses. As amended, the claims include an element admitted not taught or suggested by Dowens et al. and Dutta et al. Nothing in Hodges et al. cures the deficiencies of the underlying combination and thus, the combination of the references still does not teach or suggest the claimed invention. Applicant requests reconsideration of the rejection for this reason.

For the foregoing reasons, namely the references cited, either individually or in combination with one another, do not teach or suggest the profile containing a characteristic that changes the appearance of the message, Applicant requests reconsideration of the rejection and claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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